

male-sterile or carries the male sterile trait and at least one restorer DNA molecule encoding a restorer gene product, said restorer DNA molecule or said restorer gene product being capable of restoring the function [and/or development of [a cell/tissue] cells of a plant [that is] critical to pollen formation [and/or function that [is] are selectively interfered with by said gene product encoded by said DNA sequences of said recombinant DNA molecules.

Kindly add claims 9 through 11 as follows:

- 9. The method of any one of claims 3, 4, 5, 6, or 7 wherein said promoter causes transcription preferentially in pollen.
10. The method of any one of claims 3, 4, 5, 6, or 7, wherein said promoter causes transcription preferentially in developing microspores.
11. The method of any one of claims 3, 4, 5, 6, or 7, wherein said promoter causes expression preferentially in anther cells.--

#### REMARKS

#### **Rejection Under 35 USC § 112, Second Paragraph**

The Examiner rejected claims 4 through 7 under USC § 112, second paragraph, "as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Applicants respectfully traverse.

Specifically, the Examiner argues that the recitation in claim 4 "'the chemical agent or physiological stress defined in (a)(ii)' lacks antecedent basis in part (a)(ii) or anywhere else in the claim." Applicants presently amend claim 4 to establish the proper antecedent basis for the subject recitation.

The Examiner also argues that the recitation "the restorer trait described in C." in claim 4 is indefinite. Applicants presently amend claim 4 to adopt the Examiner's suggestion that "C." be amended to --(c)--.

Further, the Examiner argues that the recitation "when applicable" in claim 4 is redundant. Applicants presently amend claim 4 to cure that alleged redundancy.

In addition, the Examiner argues that the placement of the period at the end of part (d)(ii) in claim 4 is improper. Applicants presently amend claim 4 to correct that impropriety.

The Examiner further argues that the terminology "(if required)" in claim 4 is redundant and unduly narrative. Applicants presently amend claim 4 to delete that terminology.

Also, the Examiner argues that the use of the terminology "and/or" and "same or different" in claims 5 through 7 is "unduly narrative and alternative." Without acquiescing to the propriety of the present rejection, and solely in an effort to expedite prosecution of the present application and place it in condition for allowance, applicants presently amend claims 5-7 to clarify the subject language.

Finally, the Examiner argues that the use of the terminology "where appropriate" in claim 5 is "unduly narrative and redundant." Without acquiescing to the propriety of the present rejection, and solely in an effort to expedite prosecution of the present application and place it in condition for allowance, applicants presently amend claims 5-7 to delete the subject language.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the present rejection.

**Rejection Under 35 USC § 112, First Paragraph**

The Examiner rejected claims 1 and 3-4 under 35 USC § 112, first paragraph, arguing that "the disclosure is enabling only for claims limited to the use of genes conferring resistance to antibiotics or herbicides". (Paper No. 10 at pages 3-4). Applicants respectfully traverse.

Addressing the Examiner's statements regarding the alleged lack of examples in Applicants' specification regarding genes conferring resistance to chemical or physiological stresses, Applicants respectfully submit that a patent specification is presumed to be enabling and the PTO has the burden of establishing a *prima facie* case of lack of enablement. *See, e.g., In re Angstadt*, 190 USPQ 214, 219 (CCPA 1976); *In re Marzocchi*, 169 USPQ 367, 369-70 (CCPA 1971). To make a *prima facie* case of lack of enablement, the PTO must come forward with reasons, supported by the record as a whole, showing why the specification fails to enable one of ordinary skill in the art to make and use the claimed invention. *In re Angstadt*, 190 USPQ 219. The mere fact that some experimentation is necessary does not negate enablement so long as undue experimentation is not required. MPEP § 608.01(p). The burden is on the PTO to establish that experimentation would be undue, *Angstadt*, 190 USPQ at 219, taking into consideration the eight factors that are to be considered in determining whether a disclosure requires undue experimentation. *In re Wands*, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

Applicants respectfully direct the examiner's attention to *In re Wright*, 27 USPQ2d 1510 (Fed. Cir. 1993), in which the Federal Circuit made it clear that §112 requires objective enablement and therefore, it is irrelevant whether the teachings of the specification are provided through broad terminology or illustrative examples. Moreover, the Federal Circuit's position is consistent with the CCPA's earlier determination that a patent specification need not contain a single working example. *In re Bundy*, 209 USPQ 48 (CCPA

1981). *See also Ex parte Nardi*, 229 USPQ 79 (BPAI 1986) (the fact that the specification is devoid of working examples is without significance).

Applicants' specification provides that which is required by the extant law: teachings through the use of broad terminology in conjunction with examples which demonstrate the use of the methodology of the present invention. Although Applicants' specification contains no specific working examples relating to genes conferring resistance to chemical or physiological stresses, Applicants respectfully submit that such examples are not required, nor needed, for one skilled in the art to make and use the claimed invention. No *prima facie* case is established, and applicants respectfully request reconsideration and withdrawal of the present rejection.

Applicants respectfully submit a Petition for a One-Month Extension of Time and requisite fee. If there are any additional fees due in connection with the filing of this amendment, please charge the fees to our deposit account no. 19-0741. If a fee is required for an extension of time not accounted for, such an extension is requested and the fee should also be charged to our deposit account.

Applicants respectfully submit that the foregoing represents a complete response to the outstanding Office Action and that the application is in condition for allowance. Reconsideration and an early indication of allowability are thus respectfully requested. Should the Examiner feel that any other point requires consideration or discussion, he is invited to contact the undersigned at (202) 672-5519.

Respectfully submitted,

Don J. Pelto, Jr., P.C.

Date



Don J. Pelto  
Reg. No. 33,754

FOLEY & LARDNER  
3000 K Street, N.W., Suite 500  
P.O. Box 25696  
Washington, D.C. 20007-8696  
(202) 672-5300